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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/469,987	12/21/1999	MARK L. SKARNNESS	10559/094001	5632

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EXAMINER

NGUYEN, PHUONGCHAU BA

ART UNIT PAPER NUMBER

2665

DATE MAILED: 07/09/2004

20

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/469,987

Applicant(s)

SKARPNESS, MARK L.

Examiner

Phuongchau Ba Nguyen

Art Unit

2665

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on election 6-7-04.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 20-23 and 32-35 is/are pending in the application.
- 4a) Of the above claim(s) 24-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-23 and 32-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 2665

*Claim Objections*

1. Claims 20-23, 32-35 are objected to because of the following informalities: "a telephony over broadband telephony adapter"(claims 20-23, 32-35) should be changed to ---a broadband telephony adapter--- to be consistent with figure 2 of the original specification. Appropriate correction is required.

*Claim Rejections – 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors

Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology

Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 20, 22, 32 rejected under 35 U.S.C. 102(e) as being anticipated by Eames (6,208,637).

Regarding claims 20, 32:

Eames (6,208,637) discloses a telephony over broadband telephony adapter (combined data and telephony 1604, fig.16b);  
comprising:

a device controller (1622, fig.16b) to couple to a host controller (1700) of a broadband modem (ADSL modem 1600, fig.17);

a modulator (code 1640, fig.16b) to modulate telephony information;

a transcoder (1638, fig.16b) to transcode information between said device controller and said modulator; and

a subscriber line interface circuit (SLIC 1640, fig.16b) to couple a telephony device (to telephone via RJ11) to said modulator;

wherein the telephony device is able to communicate over a broadband line (180, figs.16) via the broadband modem (1602) by communicating via the host controller (1700) of the broadband modem (1600).

Regarding claim 22:

Eames further comprises an expansion hub (BDT 130, fig.3) to connect additional devices (in the new network, i.e., ATM network) to the host controller via the expansion hub.

*Claim Rejections – 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 21, 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eames (6,208,637) as applied to claim 20 above, and further in view of Barzegar (6,347,075).

Regarding claims 21, 34:

Eames does not explicitly disclose wherein said device controller (1622, fig.16b) is configured to operate in compliance with one of a Universal Serial Bus standard, a Firewire standard, and a wireless communication standard. However, in the same field of endeavor, Barzegar (6,347,075) discloses in figure 2 IEEE 1394 112 (firewire). Therefore, it would have been obvious to an artisan to apply Barzegar's teaching to Eames' system with the motivation being to allow incorporating the desired processing digital data onto the data network.

6. Claims 23, 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eames (6,208,637) as applied to claim 20 above, and further in view of Bauer (6,061,450).

Regarding claims 23, 35:

Eames does not explicitly disclose wherein the telephony device is able to communicate via the host controller of the broadband modem via wireless transmission between the telephony device and the broadband telephony adapter. However, in the same field of endeavor, Bauer (6,061,450) discloses wherein the telephony device is able to communicate via the host controller of the broadband modem via wireless transmission between the telephony device and the broadband telephony adapter {figure 5, 202, 507}. Therefore, it would have been obvious to an artisan to apply Bauer's teaching to Eames' system with the motivation being to pro

7. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eames (6,208,637) as applied to claim 20 above, and further in view of Bhatia (6,118,768).

Regarding claim 33:

Eames discloses wherein the telephony adapter (1604, fig.16b) has a telephone number associated therewith (inherent with the telephone, fig.16b).

Eames does not explicitly wherein said hub circuit (Ethernet hub) routes telephony information associated with telephony adapter to the first telephony device, and routes other telephony information to the at least one additional telephony device. However, in the same field of endeavor, Bhatia (6,118,768) discloses wherein said hub circuit (Ethernet hub, 340, fig.1) routes telephony information associated with telephony adapter to the first telephony device, and routes other telephony information to the at least one additional telephony device {fig.1}. Therefore, it would have been obvious to an artisan to apply Bhatia's teaching to Eames' system with the motivation being to bi-directionally route digital on either or both B-channels of ISDN connection between PSTN and analog telephone devices.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuongchau Ba Nguyen whose telephone number is 703-305-0093. The examiner can normally be reached on Monday-Friday from 10:00 a.m. to 2:00 p.m..




If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on 703-308-6602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**DUCHO**  
**PRIMARY EXAMINER**

*Ducho*  
6-28-04

  
Phuongchau Ba Nguyen  
Examiner  
Art Unit 2665